IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 778

CALMAR, INC., *Petitioner,*

v.

COOK CHEMICAL COMPANY, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit

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SUPPLEMENTAL BRIEF FOR PETITIONER

We are filing this Supplemental Brief to call to the Court's attention a very recent development which reflects the growing concern over the maintenance of the standard of patentability in the decisions of the lower courts, and indicates the appropriateness of review of this case.

On February 12, 1965, the Solicitor General filed a Petition for Certiorari on behalf of the United States in No. 906, *United States* v. *Adams*. The Solicitor General's Petition refers to the "pressing problems" relating to the administration of the patent laws which presently exist, and seeks review of a decision of the Court of Claims which the Solicitor General urges applied an improperly low standard of patentability.

The Solicitor General states (Adams Pet., p. 7):

> "We challenge the ruling not because the patentability of the Adams battery is a matter of great intrinsic importance, but because we believe that this case sharply illustrates a growing tendency in the lower federal courts to adopt and apply a new and much laxer standard of invention which, in its aggregate manifestations, seriously impairs efforts to maintain a predominantly competitive economy by creating countless unnecessary and unwarranted monopolies. . . . We think that there is need for this Court to restate, as it has in times past, the proposition that such minor technical advances are not to be rewarded with patent monopolies."

The Solicitor General makes it clear that the Government's interest lies not only in its position as defendant in patent infringement suits brought in connection with Government contracts, but, more importantly, in the fact that the Government is "charged with protecting the public interest in a competitive economy, and that includes guarding against the restraints upon competition occasioned by the indiscriminate grant of unwarranted patents." (Adams Pet., p. 13)

The Solicitor General urges that the Court review a number of cases involving the issue of the standard of patentability, in order to provide a view of the matter "in broad perspective." (Adams Pet., p. 16) He points out, in contrast to the Court's failure to grant a single petition in this area from 1950 through 1965, that during the period 1925 through 1949 "the Court reviewed the application of the standard of patentability in no less than one hundred cases." (Adams Pet., p. 15)

The Solicitor General expressly urges that our Petition be one of those granted by the Court for a plenary review of the application of the standard of patentability (Adams Pet., pp. 15-16):

> "We note that this Court has recently granted certiorari in the case of *Graham* v. *John Deere Co.*, No. 580, this Term, a case which also involves the standard of patentability. In *Graham* the Court will have before it the holding of the Eighth Circuit (in conflict with a holding of the Fifth Circuit relating to the same patent) that, in order to be patentable, a combination of old elements in a new way cannot be obvious and must bring forth a significantly different result than that disclosed by the prior art. The Court also has before it the petition in *Calmar, Inc.* v. *Cook Chemical Co.*, No. 778, this Term, likewise involving a patent on a combination, which undertakes to show that there has been a general debasement of the standard of patentability in the past decade. The government contemplates that it will shortly file a petition in the case of *Application of Andrew John Manson*, in which the Court of Customs and Patent Appeals recently held that a patent may be obtained on a process for the production of a chemical compound notwithstanding the fact that the applicant is unable to demonstrate any utility for the compound.

> "These cases and the present case afford the Court an opportunity to consider pressing problems relating to the administration of the patent laws in a variety of contexts and in broad perspective. A congressional study observed several years ago that 'the standard of invention [is] clouded in uncertainty' and 'the various circuits are unable even to agree as to the legislative intent expressed in Section 103. One view holds that the standard of patentability was unchanged by the enactment of Section 103, while the other position is that it was the intent of Congress to relax the rigid test of patentability laid down by the Supreme Court.' The need for dissipation of the prevailing uncertainty and for greater uniformity in the application of the governing standards counsels review by this Court."

The Solicitor General, following the theory of our Petition, observes, as to the standard of patentability (Adams Pet., p. 13): "that there is an urgent need to exercise a continuing measure of supervision to assure that it is not relaxed by years of unreviewed departures effectively changing, while purporting to repeat, the established rule. See, in this connection, the petition recently filed in *Calmar, Inc.* v. *Cook Chemical Co.*, No. 778, this term."

These views of the Solicitor General lend further weight to the pressing necessity of this Court's resuming a fuller participation in supervising the administration of the constitutional standard of patentability, and to the grant of certiorari in this case as part of that supervision.

CONCLUSION

For the reasons stated in the Petition, and in our Reply Brief and this Supplemental Brief, the Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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